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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,491	12/23/2003	Toshimitsu Ichiiyanagi	016907-1592	7810

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FOLEY AND LARDNER LLP  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER
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WYATT, KEVIN S

ART UNIT	PAPER NUMBER
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2878

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/19/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 10/743,491	Applicant(s) ICHIYANAGI, TOSHIMITSU	
	Examiner Kevin Wyatt	Art Unit 2878	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7,9,13,15 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7,9,13,15 and 18-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is in response to the Amendment after non-final and remarks filed on 09/26/2006. Currently, claims 7, 9, 13, 15, and 18-21 are pending.

#### ***Claim Objections***

2. Claim 7 is objected to because of the following informalities:

In claim 7, line 10, "the" should be changed to --an--.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 7, 9, 13, 15 and 18-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 7, line 5, the recited limitation "inherently printed" is unclear. It is not clear whether or not "inherently printed" means that the recording medium has an image due to a previous copying operation or a previous manufacturing process prior to performing copying operation.

In claim 13, line 9, the recited limitation "inherently printed" is unclear. It is not clear whether or not "inherently printed" means that the recording medium has an

image due to a previous copying operation or a previous manufacturing process prior to performing copying operation.

In claims 18-21, line 2, the recited limitation "inherently printed" is unclear. It is not clear whether or not "inherently printed" means that the recording medium has an image due to a previous copying operation or a previous manufacturing process prior to performing copying operation.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7, 9, 13, 15 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over.

Regarding claim 7, Shinoda shows in Fig. 1, a copying machine comprising: an optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) which optically scans a surface of a recording medium (25), and converts an image on the surface of the recording medium into image data (35 i.e., recorded information of a file, paragraph 0020, line 11); a radio reader (combination of wireless network and chip is reader terminal (71)) which reads data from an IC chip embedded in the recording medium and having a radio communication function (paragraph 0020, lines 1-11) which reads data on the surface of the recording medium from an IC chip

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(45) embedded in the recording medium (25) and having a radio communication function; an image forming unit (60, i.e., printer) which prints an image on a surface of an image forming medium (20) (paragraph 0019, lines 4-7); a control panel (paragraph 0012, lines 7-10) to which the operational mode is input by a user; an operational mode setting unit (14, i.e., program database) which sets one of the image data of the recording medium acquired by the optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) and the data read from the IC chip (25) of the recording medium by the radio reader, based on the operational mode input to the control panel; and a control unit (combination of program database(14), id managing database (12), managing server (10), wireless network, and id managing center (50)) which selects one of the image data on the surface of the recording medium (25) which has been optically scanned (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) by the optical reading unit and the data read from the IC chip (25) embedded in the recording medium by the radio reader, as the image data to be printed on the surface of the image forming medium (20) by the image forming unit (60, i.e., printer), based on the operational mode set by the operational mode setting unit (14, i.e., program database). Shinoda does not disclose that the radio reader reads image data from an IC chip embedded in the recording medium. Yoda discloses a printing medium having an IC chip, which permits image data to be read wirelessly from the chip (paragraph 004, lines 19-27). It would have been obvious to one skilled in the art to provide the printing medium of Yoda to the device of Shinoda for

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the purpose of providing additional file sharing capabilities, storing image data in addition to authentication data.

Regarding claim 13, Shinoda shows in Fig. 1, a copying machine comprising: a scanner (71, i.e., reader terminal); a printer (60), and a system control unit, wherein the scanner includes: an optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) which optically scans a surface of a recording medium (25, i.e., recording medium), and converts an image on the surface of the recording medium into image data (35, i.e., document); and a radio reader (combination of wireless network and chip id reader terminal (71) ) which reads data from an IC chip (45, i.e., contactless IC chip) embedded in the recording medium (25) and having a radio communication function (RFID, i.e., Radio Frequency Identifier, paragraph 0024 lines 1-5), the printer includes: an image forming unit (60, i.e., printer) which prints an image on a surface of an image forming medium (20, i.e., recording medium), and a control panel (paragraph 0012, lines 7-10) to which an operational mode is input by the user; an operational mode setting unit (14, i.e., program database) which sets one of the image data of the recording medium (25) acquired by the optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) and the data read from the IC chip (25) of the recording medium by the radio reader, based on the operational mode input to the control panel; and a control unit (combination of program database(14), id managing database (12), managing server (10), wireless network, and id managing center (50)) which selects one of the image data on the surface of the recording medium which has been optically scanned by the optical reading unit and the

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data read from the IC chip (25) embedded in the recording medium by the radio reader, as the image data to be printed on the surface of the image forming medium (20) by the image forming unit, based on the operational mode set by the operational mode setting unit (14, i.e., program database). Shinoda does not disclose that the radio reader reads image data from an IC chip embedded in the recording medium. Yoda discloses a printing medium having an IC chip, which permits image data to be read wirelessly from the chip (paragraph 004, lines 19-27). It would have been obvious to one skilled in the art to provide the printing medium of Yoda to the device of Shinoda for the purpose of providing additional file sharing capabilities, storing image data in addition to authentication data.

Regarding claim 9, Shinoda further shows in Fig. 1 a radio writer (combination of wireless network and id managing center (50)) which writes data on an IC chip (40, recording medium) embedded in the image forming medium (20) and having a radio communication function; wherein the operational mode setting unit (14, i.e., program database) sets one of the image data (30) of the recording medium acquired by the optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) and the data read from the IC chip (45) of the recording medium by the radio reader (combination of wireless network and chip is reader terminal (71)), as the data to be written on the IC chip (40) embedded in the image forming medium (20) by the radio writer (combination of wireless network and id managing center (50)) which writes data on an IC chip (40) embedded in the image forming medium (20, i.e., recording medium) and having a radio communication function (paragraph 0017, lines 1-3), based on the

operational mode input to the control panel, and wherein the control unit (combination of program database(14), id managing database (12), managing server (10), wireless network, and id managing center (50)) selects one of the image data on the surface of the recording medium (25) which has been optionally scanned by the optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) and the data read from the IC chip (45) embedded in the recording medium (25) by the radio reader (combination of wireless network and chip id reader terminal (71)) as the data to be written on the IC chip (40) embedded in the image forming medium (20) by the radio writer based on the operational mode set by the operational mode setting unit (14, i.e., program database).

Regarding claim 15, Shinoda further shows in Fig. 1 that the printer further includes: a radio writer (combination of wireless network and id managing center (50)) which writes data on an IC chip (40, contactless IC chip) embedded in the image forming medium (20) and having a radio communication function, wherein the operational mode setting unit (14, i.e., program database) sets one of the image data of the recording medium (25) acquired by the optical reading unit (i.e., a scanner function to acquire image data, paragraph 0020, lines 8-9) and the data read from the IC chip (45) of the recording medium (25) by the radio reader (combination of wireless network and chip id reader terminal (71)) as the data to be printed as the image on the image forming medium (20) by the image forming unit (60, i.e., printer), based on the operational mode input to the control panel, wherein the control unit of the system control unit selects one of the image data on the surface of the recording medium which



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has been optically scanned by the optical reading unit of the scanner and the data read from the IC chip (45) embedded in the recording medium by the radio reader of the scanner (71, i.e., reader terminal), as the data to be written on the IC chip (40) embedded in the image forming medium by the radio writer, based on the operational mode set by the operational mode setting unit (14, i.e., program database).

Regarding claims 18-21, Shinoda discloses the claimed invention as stated above. Shinoda does not disclose that the radio reader reads electronic data, which corresponds to the image data recorded on the surface of the recording medium, from the IC chip embedded in the recording medium. Yoda discloses a printing medium having an IC chip, which permits image data to be read wirelessly from the chip (paragraph 004, lines 19-27). It would have been obvious to one skilled in the art to provide the printing medium of Yoda to the device of Shinoda for the purpose of providing additional file sharing capabilities, storing image data in addition to authentication data.

### ***Response to Arguments***

7. Applicant's arguments filed 09/26/2006 have been fully considered.

In response to applicants arguments that Shinoda does not disclose or suggest any features in which data to be printed on a surface of an image forming medium can be selected from an image on a surface of an original or an image based on the data stored in the IC chip embedded in the original. The examiner acknowledges that Shinoda does not disclose a recording medium designed to record image data or that

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Shinoda reads image data from its contactless IC chip (45). However, the examiner provides that it would have been obvious to combine the recording medium of Yoda due to the fact that Yoda's recording medium provides an IC chip embedded in the recording medium which permits reading and writing of both authentication data and image data to and from wireless networks to peripheral devices.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Wyatt whose telephone number is (571)-272-5974. The examiner can normally be reached on Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps can be reached on (571)-272-2328. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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